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PATENT  
P56255

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES**

In re Application of:

**Appeal No.** \_\_\_\_\_

DONG-YOUL LEE

Serial No.: 09/805,929

Examiner: DANIEL JR, WILLIE J

Filed: 15 March 2001

Art Unit: 2617

For: CALL ORIGINATING SERVICE METHOD IN A PUBLIC AND PRIVATE  
COMMON MOBILE COMMUNICATION SYSTEM AND APPARATUS

**REPLY BRIEF**

**Paper No. 38**

**Mail Stop Appeal Brief-Patents**

Commissioner for Patents

P.O.Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §41.41(a), Appellants hereby request entry of this Reply Brief in response to the Examiner's Answer mailed on 2 October 2008.

This Reply Brief is filed with a written Request for Oral Hearing before the Board of Patent Appeals and Interferences, and the statutory fee incurred by that request.

Folio: P56255

Date: 12/2/08

I.D.: REB/ML/kn

### **REMARKS**

The Examiner's Answer mailed on 2 October 2008 has been carefully considered in view of the issue on appeal:.

**Does the applied prior art of Paper No. 10 (Widergen (USP 5,890,064), Mauger (USP 5,537,610), Fujii (USP 5,818,918)), either singly or in combination, fairly teach or suggest transparent transmission<sup>1</sup> of a call origination message<sup>2</sup> from a public/private communication service to a public BSC?**

Appellant will now attempt to address each of the Examiner's allegations found on Pages 23-33 ("Response to Argument") of the October 2, 2008 Examiner's Answer:

#### **1. Appellant's response to A1 and A2 on Pages 23 and 24 of the Examiner's Answer**

On Pages 23 and 24 of the Examiner's Answer, the Examiner states that "Appellant

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<sup>1</sup>transparent transmission means transmission without modification in form or information content. Transparent transmission also involves the case where the user information is changed and then restored to its original form prior to output without the involvement of the user. On Pages 10 and 11 of Applicant's January 30, 2007 Amendment, Applicant provided three standardized definitions of this term and included the same in an IDS

<sup>2</sup>A call origination message is defined as a packet message as per FIG. 7 and paragraphs 0032 through 0035 of Applicant's originally filed specification. The call origination message or packet message has many fields, such as a source address field(SRC\_ADDR), a destination address field (DEST\_ADDR), a message length field (LENGTH), message field (MSG), message type field (TYPE), etc. For a call to a public mobile network, this call origination message is sent from the originating MS to a pBTS and to public/private communication service unit 12 and then to the BSC 4<sub>m</sub> and MSC 2<sub>1</sub>. This is done without changing the call origination message

argues ... call origination message is the packet ..."<sup>3</sup> and responds by saying limitations from the specification are not to be read into the claims. Appellant has the following comments:

Applicant has explained throughout prosecution that Applicant's claimed origination message is a packet message that goes from public/private communication service unit 12 to public BSC. Applicant illustrates such a packet message or call origination message in FIG. 7. In the prior art rejections, it is the Examiner's position that since Widergen teaches that a dialed telephone number is transparently sent, that this reads on Applicant's transparent transmission of a call origination message under the rationale that limitations of the specification can not be read into the claims. Applicant disagrees.

To begin with, an Applicant can be his own lexicographer. In the present case, Applicant has defined a call origination message to be a packet message (see Applicant's paragraphs 0033 and 0034). Applicant has further defined the call origination message or packet message to have the structure of Applicant's FIG. 7, which is something entirely different from a mere telephone number. Furthermore, the term call origination message and packet message is known in the art of mobile communications to be a message that is entirely unlike a mere telephone number. It contains source and destination addresses, length type a recorded message etc. As a result, a call origination message or a packed message in the context of a mobile

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<sup>3</sup>In Appellant's Appeal Brief, this sentence read "a call origination message is the packet as illustrated in FIG. 7."

communication system has a meaning that is all together repugnant to that of a mere telephone number. Because Applicant has defined a call origination message in Applicant's specification and figures, and because it has a meaning in the mobile communications art to be something all together different and repugnant to that of a mere telephone number, Applicant submits that it is entirely unreasonable for the Examiner to try to equate Widergen's mere telephone number with Applicant's call origination message. As a result, Appellant submits that the Examiner's assertion that limitations in the specification of a call origination message can not be read into the claims is misplaced.

**2. Appellant's response to Examiner's charge in the middle of Page 24 of the Examiner's Answer**

In the middle of Page 24 of the Examiner's Answer, the Examiner states, "appellant admits ...Widergen actually teaches that the call origination message ..."4. This is taken out of context. The full sentence reads, **"Widergen actually teaches that the call origination message is permanently changed"**. Appellant stated this in his Appeal Brief to stress that Widergen actually teaches away from Applicant's transparent transmission of a call origination message. Because Widergen permanently changes the call origination message, it can not be said that Widergen teaches transparent transmission of a call origination message as asserted by the Examiner. Appellant is not making any admission the above statement. Appellant is

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<sup>4</sup>In Appellant's Appeal Brief, this sentence read "Widergen actually teaches that the call origination message is permanently changed."

explaining instead that Widergen teaches away from Appellant's transparent transmission of a call origination message. Once again, the Examiner twists Appellant's argument and takes it out of context to lead one to believe that Appellant is making an admission when Appellant is trying to explain that the applied prior art of Widergen teaches away from Appellant's claims.

**3. Appellant's reply to Examiner's Comments B1 and B2 on Pages 24-27 of the Examiner's Answer**

In each of independent claims 16, 17 and 18, Appellant claims the transparent transmission of a call origination message. In the prior art rejections, the Examiner rejects these claims using Widergen in view of Mauger. To support these claim rejections, the Examiner explains that each of Widergen and Mauger taken alone teaches transparent transmission of a call origination message. In response, Appellant argued that neither Widergen nor Mauger teach transparent transmission of a call origination message. Appellant then further argued that Widergen actually teaches away from transparent transmission of a call origination message. In response to this, the Examiner charges, on Pages 24 through 27 of the Examiner's Answer, that Appellant, in explaining that each of Widergen and Marger teach away from Appellant's transparent transmission of a call origination message, is arguing against the references individually and thus does not appreciate the combined teachings of Widergen and Mauger. Specifically, the Examiner quotes Examiner form paragraph 7.37.13 which states:

“In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d

413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).” Applicant disagrees.

Appellant submits that such a charge by the Examiner is inapplicable to the facts of the present case and is thus a costly and misleading diversion from what should be the proper authority (MPEP 2143.03) in the present patent application 09/805,929.

For example, in the In re Keller case, the claimed invention is a cardiac pacer having a digital computer. The Examiner rejected the claims using a Keller patent in view of a Walsh patent. The Keller patent taught a cardiac pacer with an analog equivalent. The Examiner admitted that the Keller patent failed to teach the digital time piece. For this feature, the Examiner turned to Walsh. Walsh teaches a digital time base generator, but not in the environment of a cardiac pacer. The Appellant argued that such a rejection is improper because one of ordinary skill in the art in the art of pacers would not expect that it would be desirable or advantageous to use the digital circuitry of Walsh in the pacer of the Keller patent. Although this scenario is entirely not applicable to the present patent application 09/805,929, the court disagreed with Appellant’s argument by ruling that Appellant failed to appreciate the combined teachings of both the Keller and the Walsh patents.

In the present case of 09/805,929, it is the Examiner’s position that Widergen by itself teaches the transparent transmission of a call origination message. Appellant denies this. It is also the Examiner’s position that the Fujii patent by itself teaches the transparent transmission

of a call origination message. It is also the Examiner's position that the Mauger patent by itself teaches the transparent transmission of a call origination message. Appellant again denies this. Because the Examiner based his alleged teaching of transparent transmission of a call origination message on Widergen, Mauger and Fujii individually and not on some combination of references, Appellant submits that Examiner's Form paragraph 7.37.13 and the In re Keller case are not applicable to the present patent application. Instead, Appellant submits that the relevant authority is MPEP 2143.03, which states that all claim limitations must be taught or suggested.

Here, neither the Examiner's proposed combination of Widergen, Mauger and Fujii, nor any of Widergen, Mauger nor Fujii taken either individually or in any of several possible combinations, nor any applied reference or any combination of the applied prior art references either teaches or suggests transparent transmission of a call origination message. This raises grave concerns that the Examiner fails to appreciate the presence of the art recognized terms *call origination message* and *transparent transmission* in the definitions provided by the pending claims. As explained by such exemplars of the art as Sinnarajah *et al.* filed by Qualcomm, Incorporated, U.S. Patent No. 7.328.022 issued on the 5<sup>th</sup> of February 2008, in, by way of example, independent apparatus claims 1 and 2, *call origination message* is sent "to the network", and in the particular embodiments claimed by Sinnarajah *et al.* '022, may be is sent "to the network" "responsive to the operator initiation of an outgoing point-to-point call to a remote station" so as to enable a manager in a wireless communications network to "perform operations" and "complete the point-to-point call." Appellant submits that this is structurally

and functionally different from the dialed telephone number “sent” in the practice of the the Examiner’s proposed combination of Widergen, Mauger and Fujii.

And, as further explained in such other exemplars of the art as Ruckstuhl filed by Siemens Aktiengesellschaft, U.S. Patent No. 7.324.503 issued on the 29<sup>th</sup> of January 2008, *transparent transmission*, as applied to the practice of the embodiments of Ruckstuhl ‘503 defined by independent process claim 1, is a transmission of “signaling between the IAD and the VoIP controller” in order to make “telephony services available by way of xDSL connection lines”, ostensibly when the mobile station is already receiving broadcast content. Appellant again submits that this is structurally and functionally different from the dialed telephone number “sent” in the practice of the the Examiner’s proposed combination of Widergen, Mauger and Fujii.

In the prior art rejections of Appellant’s claims 16-18 in Paper No. 10 and in the Examiner’s Answer, it is the Examiner’s position that Widergen in view of Mauger renders Applicant’s transparent transmission of a call origination message unpatentable because each of Widergen and Mauger individually and in their own right teaches the transparent transmission of a call origination message. The Examiner provides the cites of numerous passages from each of Widergen and Mauger<sup>5</sup> that allegedly show transparent transmission of a call origination message. Furthermore, the Examiner states:

“Widergen inexplicitly discloses having the feature(s) of transparently transmitting the call origination message to one of the plurality of public mobile

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<sup>5</sup>See Page 7-9 of the Examiner’s Answer and Pages 5-7 of Paper No. 10 for example



communication network BSCs. However, the examiner maintains that the feature(s) of transparently transmitting the call origination message to one of said plurality of public mobile communication network BSCs was well known in the art, as taught by Mauger.”

In the same field of endeavor, Mauger discloses the feature(s) of transparently transmitting the call origination message to one of said plurality of public mobile communication network BSCs ...”<sup>6</sup>

Therefore, in rejecting Applicant’s transparent transmission of a call origination message feature, the Examiner bases his 35 U.S.C. 103 rejection of Appellant’s transparent transmission of a call origination message on proposition that each of Widergen and Mauger individually and by themselves teach transparent transmission of a call origination message. Because the Examiner, in the rejection, states that each of Widergen and Mauger teach, on their own, the transparent transmission of a call origination message, Appellant, in response to this position of the Examiner in Paper No. 10 and in the Examiner’s Answer, both during prosecution and during appeal, tried to explain why the cited passages of each of Widergen and Mauger do not teach transparent transmission of a call origination message. Appellant also explained why Widergen teaches away from transparent transmission of a call origination message. And, in response to these explanations, the Examiner comes back and charges that Appellant is arguing against the references individually and fails to appreciate the combined teachings of the combined prior art. Appellant argued against the references individually to respond to the Examiner’s rejection and the allegations the Examiner made to support his rejection, that being that the Examiner stated that each of the individual references individually teaches transparent

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<sup>6</sup>See Page 8 of the Examiner’s Answer and Page 6 of Paper No. 10 for example

transmission of a call origination message.

Because the Examiner's relied on the individual teachings of each of Widergen and Mauger to support his 35 U.S.C. 103 rejection of Appellant's transparent transmission of a call origination message limitation in the prior art rejections of claims 16-18, and because it was not the position of the Examiner that only the combined teachings of Widergen and Mauger teach transparent transmission of a call origination message, Appellant submits that the Examiner's assertion that Appellant argues against the references individually and does not address the combined teachings of the prior art is misplaced and is a distraction from the progression of patent prosecution.

**4. Appellant's reply to Examiner's Comments C1 and C2 on Pages 27-30 of the Examiner's Answer**

In independent claim 19, Appellant claims the transparent transmission of a call origination message to the BSC of the PLMN. In this prior art rejection, the Examiner rejects this claim using Widergen in view of Fujii. To support this claim rejection, the Examiner states that each of Widergen and Fujii taken alone teaches transparent transmission of a call origination message. In response, Appellant argued that neither Widergen nor Fujii teach transparent transmission of a call origination message. Appellant then further explained why Widergen actually teaches away from transparent transmission of a call origination message. In response to this, the Examiner charges, on Pages 27 through 30 of the Examiner's Answer,

that Appellant, in explaining that neither Widergen nor Fujii teach transparent transmission of a call origination message, is arguing against the references individually and thus does not appreciate the combined teachings of Widergen and Fujii. Appellant submits that such a charge by the Examiner is misleading and misplaced, because it has been the Examiner's position that the transparent transmission of a call origination message of Appellant's claim 19 is unpatentable because each of Widergen and Fujii, on their own individually, teach transparent transmission of a call origination message.

In the prior art rejection of Appellant's claim 19 in Paper No. 10 and in the Examiner's Answer, it is the Examiner's position each of Widergen and Fujii by themselves teaches Appellant's transparent transmission of a call origination message. It has never been the Examiner's position that neither Widergen nor Fujii teach transparent transmission of a call origination message, but that Widergen as modified according to Fujii teaches transparent transmission of a call origination message. The Examiner provides the cites of numerous passages from each of Widergen and Fujii<sup>7</sup> that allegedly show transparent transmission of a call origination message. Furthermore, the Examiner states:

“Widergen inexplicitly discloses having the feature(s) of transparently transmitting the call origination message to a base station controller (BSC) of the PLMN. However, the examiner maintains that the feature(s) [of] transparently transmitting the call origination message to a base station controller (BSC) of the PLMN was well known in the art, as taught by Fujii.”

In the same field of endeavor, Fujii discloses the feature(s) [of]

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<sup>7</sup>See Page 16 and 17 of the Examiner's Answer and Pages 14 and 15 of Paper No. 10

transparently transmitting the call origination message [to] a base station controller (BSC) of the PLMN (see col. 2, lines 25-45; Figs. 1), ...”<sup>8</sup>

Therefore, in rejecting Applicant’s transparent transmission of a call origination to a BSC of a PLMN limitation, the Examiner relies on the individual teachings of each of Widergen and Fujii to show that the applied prior art teaches transparent transmission of a call origination message to a BSC of a PLMN. Because the Examiner, in the rejection of claim 19, relies on the individual teachings of Widergen and Fujii to show that transparent transmission of a call origination message is unpatentable, Appellant, in response to this position of the Examiner in Paper No. 10 and in the Examiner’s Answer, both during prosecution and during appeal, tried to respond to the Examiner’s reasoning by explaining why each of the cited passages of each of Widergen and Fujii do not fairly teach or suggest transparent transmission of a call origination message. Appellant further explained why Widergen actually teach away from Appellant’s transparent transmission of a call origination message to a BSC of a PLMN. And, in response to these explanations, the Examiner comes back and charges that Appellant is arguing against the references individually and fails to appreciate the combined teachings of the combined prior art. Appellant argued against the references individually because the Examiner’s 35 U.S.C. 103 rejection is based on the individual teachings of Mauger and Fujii.

Because the Examiner’s relied on the individual teachings of each of Widergen and Fujii

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<sup>8</sup>See Page 17 of the Examiner’s Answer and Pages 14 and 15 of Paper No. 10

for a teaching of transparent transmission of a call origination message in the prior art rejection of claim 19, and because it was not the position of the Examiner that only the combined teachings of Widergen and Fujii teach transparent transmission of a call origination message, Appellant submits that the Examiner's assertion that Appellant argues against the references individually and does not address the combined teachings of the prior art is a complete disconnect from the reasoning the Examiner gave to reject Applicant's claim 19.

**5. Appellant's reply to the Examiner's comments D1, D2, E1 and E2 on Pages 30 to 33 of the Examiner's Answer**

Throughout prosecution, Appellant has explained many times to the Examiner that Widergen actually teaches that the call origination message is changed and is not transferred transparently. For example, on Pages 12 and 13 of Appellant's January 30, 2007 amendment, Appellant explained why Widergen teaches away from transparent transfer of a call origination message by saying:

“Applicant submits that this instance of the word “transparently” in Widergen [col 9, line 49 of Widergen] pertains to the transfer of a dialed number, not a call origination message as claimed by Applicant. Applicant further submits that Widergen teaches that the call origination message is not transferred transparently in col 5, lines 7 through 12 where it says that the call origination message is converted from the CMT into a message according to the MSC to MSC signaling, and then the converted message is transmitted. Applicant submits that converting to MSC to MSC signaling means that the call origination message is not transmitted transparently in Widergen as asserted by the Examiner at the November 14, 2006 interview.

In summary, col 5, lines 49-53 and col 9, line 39 to col 10, line 1 (i.e., explanation of case 5) of Widergen teach that a call from a CMT located in a wireless office system 142 to a PMT is completed through the following routes, a RAN 126 to WO gateway 124 to PTN 108 to PSTN 104 to GMSC 136 and to MSC 112. Further, col 2, lines 33 to 37 and FIG. 1 of Widergen teach that a WO gateway 142 of the wireless office system 142 is connected to an MSC 112 of public cellular system 140 via an interface C, and col 5, lines 7 to 12 of Widergen teach that the signaling between the WO gateway 124 and the MSC 112 follows the MSC to MSC signaling. Therefore, from case 5 of Widergen in col 9, lines 48 to 50, Widergen only teaches transparently transmitting a dialed number to the PTN 108, and Widergen does not teach transparently transmitting a call origination message. Instead, Widergen teaches converting the call origination message from the CMT into a message according to the MSC to MSC signaling, and transmitting the converted message.”

Contrary to the teachings of Widergen, Applicant’s invention teaches connecting a public/private communication service unit to a public mobile communication network’s BSC. As seen in Applicant’s FIG. 2, pBSC 40 of the public/private communication service unit 12 is connected to a BSC 4-m of a PLMN, and also, a call origination message from an MS is transmitted from the pBSC 40 to the BSC 4-m. As a result, the call origination message from the MS (i.e., a message according to the mobile communication signaling) disclosed in Applicant’s invention is not converted into a message according to the MSC to MSC signaling as in Widergen, but is transparently transmitted to the BSC 4-m. For this reason, Widergen does not teach transparent transmission of a call origination message as claimed by Applicant. Applicant further submits that Widergen teaches that the call origination message is not transferred.”

Appellant restated this again on Page 19 of Appellant’s Corrected Appeal Brief by saying:

“Specifically, Appellant submits that col 5, lines 49-53 and col 9, line 39-col 10, line 1 of Widergen teach that a call from a CMT located in a wireless office system 142 to a PMT is completed through the route of RAN 126-WO gateway 124-PTN 108-PSTN 104-GMSC 136-MSC 112. *Appellant submits that in this scenario of Widergen, the call origination message is changed in this scenario to route the call from the wireless communication network to the wired communication network.*

Appellant also submits that col 2, lines 33-37 and FIG. 1 of Widergen teach that WO gateway 142 of the wireless office system is connected to an MSC 112 of a public cellular system 140 via interface C, and also, from col 5, lines 7-12 of Widergen it can be known that the signaling between the WO gateway 142 and the MSC 112 follows the MSC to MSC signaling which changes the call origination message without it being restored. Because of this, Appellant submits that Widergen actually teaches that the call origination message is permanently changed."

On Pages 30 and 31 of the Examiner's Answer, the Examiner dismisses the above analysis and explanation by merely saying, "Appellant has failed to interpret and appreciate the combined teachings of the prior art Widergen with Mauger (for claims 16-18) or Fujii (for claim 19) that clearly disclose the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art." Appellant objects.

As stated previously, the Examiner, in his prior art rejections of claims 16-19, states that each of Widergen, Mauger and Fujii individually teach transparent transmission of a call origination message. This is the basis from which the Examiner concludes that Applicant's transparent transmission of a call origination message is unpatentable. Appellant has responded by explaining why none of the prior art references disclose, teach or suggest the transparent transmission of a call origination message contrary to the Examiner's allegations. Furthermore, the Examiner has never articulated, during prosecution or appeal, why the combination of Widergen in view of Mauger or the combination of Widergen in view of Fujii would teach transparent transmission of a call origination message when none of the constituent individual references to Widergen, Mauger and Fujii teach the transparent transmission of a call

origination message. Because of an absence of such an articulation on the part of the Examiner, Appellant submits that the Examiner's continuous proclamations of Appellant failing to interpret or appreciate the combined teachings of the prior art references is misplaced and not pertinent to the Examiner's reasons for the rejections.

On Pages 32 and 33 of the Examiner's Answer, the Examiner continues to assert that he, and not Appellant, carefully and properly followed the procedure of *Graham v John Deere* 383 U.S. 1, 148 USPQ 459 in formulating a 35 U.S.C. 103 (a) rejection by properly appreciating the combined teachings of the prior art. Appellant disagrees.

In the Examiner's rejections of independent claims 16-19, the Examiner explains how each of Widergen, Mauger and Fujii individually and in their own right teach Appellant's transparent transmission of a call origination message to support the Examiner's conclusion that the combinations of Widergen in view of Mauger and Widergen in view of Fujii render Appellant's transparent transmission of a call origination message unpatentable. The Examiner never said that none of the applied prior art references on their own teach a transparent transmission of a call origination message, but the combinations of Widergen in view of Mauger and Widergen in view of Fujii do teach the transparent transmission of a call origination message. Hence, the Examiner's position is that Widergen in view of Mauger render Appellant's transparent transmission of a call origination message unpatentable because each of Widergen and Mauger teach transparent transmission of a call origination message.



Likewise, it is the Examiner's position that Widergen in view of Fujii render Appellant's transparent transmission of a call origination message unpatentable because each of Widergen and Fujii teach transparent transmission of a call origination message.

Appellant further submits that the Examiner would like to convince the board that by some mysterious and unarticulated hocus pocus that the combined teachings of Widergen and Mauger and Widergen and Fujii somehow teach transparent transmission of a call origination message without clearly articulating how. However, in reality, the Examiner rejected Appellant's transparent transmission of a call origination message limitation under 35 U.S.C. 103 (a) using Widergen in view of Mauger because each of Widergen and Mauger by themselves teach transparent transmission of a call origination message. Likewise, the Examiner rejected Appellant's transparent transmission of a call origination message limitation to a BSC of a PLMN limitation of claim 19 under 35 U.S.C. 103 (a) using Widergen in view of Fujii because each of Widergen and Fujii by themselves teach transparent transmission of a call origination message. And to this, Appellant has articulated with great specificity why 1) none of Widergen, Mauger and Fujii teaches transparent transmission of a call origination message to rebut the Examiner's allegations and 2) explained why Widergen actually teaches away from Applicant's claims by explaining why Widergen does not transparently transmit a call origination message. Instead of being direct and addressing Appellant's arguments in these regards, the Examiner denies Appellant's patent application my merely saying that Appellant fails to interpret and appreciate the combined teachings of the prior art, a comment Appellant

can not respond because in the Examiner's rejections, it is the Examiner's position that each of the constituent applied prior art references individually teach the transparent transmission of a call origination message.

The Examiner then asserts in the middle of Page 31 of the Examiner's Answer that Appellant says that transparent transmission includes the scenario of where a message is changed but later restored. Appellant submits that this is irrelevant because none of the applied prior art references change and then restore a call origination message. To the contrary, as explained above, Widergen positively and permanently changes the call origination message.

## 6. Closing Comments

The Board should pause to consider that Appellant's claims 16-19 are not the type of claims found in *KSR Int'l Co. v. Teleflex Inc.*<sup>9</sup> were every element, that is, both the electrical switch and the brake petal assembly, were standard off-the-shelf items that had been previously used in the same industry, for the same purpose, for many years, to achieve the same result. In *KSR*, neither the claim when read in its entirety, nor the two paragraphs that defined the switch and assembly, did anything more. Consequently, and in conformance with the precedential principles laid down by *Hotchkiss v. Greenwood*,<sup>10</sup> affirmed its principle of the "functional

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<sup>9</sup> *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 82 USPQ2d @1395 (2008).

<sup>10</sup> *Hotchkiss v. Greenwood*, 11 Howard 248.

approach” that “[t]he combination of familiar elements according to known method is likely to be obvious when it does no more than yield predictable results.”<sup>11</sup>

Here, and unlike *KSR*, the Examining staff has failed to show that many of the constituent elements of Appellant’s claims 16-19 has ever been known in the art, and has failed to show the operational functions (namely Applicant’s transparent transmission of a call origination message defined by Appellant’s claims 16-19), or the results (namely, an unchanged call origination message, especially for a call to a public mobile communication system from the public/private communication service unit defined by Appellant’s claims 16-19) attained by these operational functions performed by this structure of claims 16-19 have ever existed in the art outside of Appellant’s specification. The Board is urged to consider that the procedural standard established by 35 U.S.C. §103(a) requires that “the *differences* between the subject matter sought to be patented and the prior art” must be identified; that standard has not been met here where the outstanding Office action as attributed to the Examiner’s proposed combination the nomenclature, operational functions and results attained when these properties can not be found by a thorough reading of that proposed combination. To paraphrase the Board of Appeals, how may this art be said to teach these features of Appellant’s claims 16-19 when that art does not use the words of claims 16-19? These deficiencies in the art are the “differences” which must be identified under 35 U.S.C. §103(a). Absent any identification of these “differences” in the administrative record for this application, the procedural standard of 35


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<sup>11</sup> *Ex parte Mary Smith*, Appeal No. 2007-1925 (BPAI 2007).

U.S.C. §103(a) has not been met. Consequently, there is no *prima facie* showing of obviousness on the administrative record before the Office. Withdrawal of this rejection is therefore respectfully urged.

A Request for Oral Hearing and an Appellants' check in the amount of \$1,080.00 drawn to the order of Commissioner accompany this Reply Brief. Should the Request and/or check become lost, the Commissioner is kindly requested to treat this paragraph as such a request, and is authorized to charge Deposit Account No. 02-4943 of Appellants' undersigned attorney in the amount of such fee.

Respectfully submitted,

  
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